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REMARKS

Claims 1-11 were pending. Claims 1, 3, 5, 6, 8 and 9 are amended. New claims 18-23 have been added. No new matter has been added. Claims 1-11 and 18-23 are now pending.

Request for Continued Examination - 35 CFR 1.32(b)

Applicant is filing herewith a Request for Continued Examination. Authorization to pay the examination fee is included with this response.

Response to Arguments

Applicant respectfully thanks the Examiner for the acceptance of the previously submitted documents adding Randall Eric Swanson as an inventor and qualifying the present application as a continuation-in-part of the previously-filed parent application, now U.S. Patent No. 6,607,621 ("Swanson" or "the '621 patent"). Based on the continuation-in-part status of the present application, Applicant is therefore entitled to the priority date of the '621 patent with respect to the subject matter originally disclosed in that application.

As requested by the Examiner, Applicant has submitted herewith the Inventorship Declaration of Jerry E. Brower ("Brower Decl."), explaining the relationship between the inventive entities in this application and the '621 patent. More particularly, as identified in the Brower Decl., Mr. Swanson is the sole inventor with respect to the subject matter of the '621 patent. Mr. Brower, however, is the inventor with respect to the new subject matter introduced in the present continuation-in-part application.

Claim Rejections

The Examiner has maintained the rejections of claims 1-11 based on the combination of Swanson with either U.S. Patent No. 5,075,149 ("Owens") or U.S. Patent No. 6,231,949 ("Hoffman") and for claims 6-8 in further view of U.S. Patent No. 4,122,222 ("Parker").

Claims 1-4 have been amended, and new claims 18 and 22 have been added, such that these claims are based solely on the inventive contributions of Mr. Swanson originally disclosed in the parent application. Each of these claims is therefore entitled to the priority date of the '621 patent and the Examiner's rejections based on Swanson, with respect to these claims, are overcome. Accordingly, these claims are believed to be in condition for allowance.

With respect to claims 5-11, 19-21 and 23, each of these claims recite the inventive contributions of Mr. Brower in addition to those of Mr. Swanson found in the parent

application. While therefore not entitled to the earlier priority date, these claims are nonetheless patentable over the combination of the references of record because the cited references fail to supply all of the limitations of the claims and further lack any motivation to combine them to provide the claimed structure. The cited references also teach away from the proposed combination.

The Examiner relies on Owens or Hoffman to supply the teaching of an aperture in a wall patch having the inventive features of Swanson. Neither Owens or Hoffman, however, teach the missing claim elements or provide a motivation to supply the Swanson wall patch with the aperture disclosed and claimed in the present application. Instead, Owens and Hoffman both teach away from the present invention. Significantly, neither Owens nor Hoffman teach an aperture formed through the entire patch structure to surround a wall element, but instead, each reference teaches only that multiple holes may be provided in an internal element of the patch to receive other patch structures. Both references specifically teach that the internal holes are filled in and/or covered by other elements of their patches and thereby render their patches incapable of supplying the claimed invention.

With respect to Owens, the disclosure cited by the Examiner (col. 3, lines 14-15), for instance, simply teaches that the plastic sheet or metal plate 11 may be perforated. Not only does this fail to teach an aperture of sufficient size to surround a wall element, it further fails to even suggest an aperture extending through the entire patch, and instead teaches away from the claimed invention. As shown in FIG. 2 and explained throughout Owens, the plastic sheet or metal plate is simply one part of the composite structure forming the patch 10. The Owens disclosure makes it clear that each of the perforations formed in the plate or sheet 11 are filled in and/or covered by numerous other elements of the wall patch, including, e.g., the adhesive 15, polyester sheets 13, 14, adhesive layer 17, and primer 16. These perforations therefore cannot provide the claimed aperture which extends through the wall patch, let alone a hole sufficiently sized to surround a wall element.

Owens further fails to supply any motivation whatsoever to provide these perforations in the Swanson patch, particularly since Swanson expressly teaches away from the complex composite structure of Owens. Owens therefore not only fails to supply the missing limitations or a motivation to combine the references, but the references teach away from making the proposed combination.

Similarly, Hoffman teaches only that the openings 20 are formed in the sheet 12 portion of the repair patch 10. See, e.g., col. 4, lines 13-26. Hoffman further teaches that the

openings 20 are covered "with a thin layer of plaster of paris, gypsum material, spackling compound, joint compound, fiberglass resin compound, spackle or other curable repair compound 25 which completes the assembly." Col. 5, lines 50-55; *see also*, FIGS. 2-4. The wall patch 10 of Hoffman therefore also lacks apertures formed through the wall patch and fails to teach the missing limitations of the claimed invention.

Hoffman similarly fails to provide a motivation to combine. The openings 20 in Hoffman receive the curable repair compound 25. Since the wall patch in Swanson expressly avoids the need for a curable repair compound, however, there would be no motivation to provide the Swanson wall patch with the openings of Hoffman. And, as with Owens, Hoffman also directly teaches away from a wall patch having an aperture formed through the patch by teaching that its openings 20 are to be covered with the repair compound 25 to complete the patch 10.

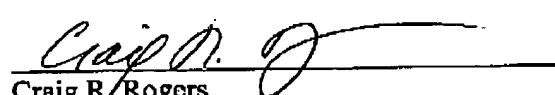
For at least these reasons, claims 5, 19, and 23 are each allowable over the art of record. The additional claims dependent therefrom contain other limitations not found in the art of record. For instance, Hoffman and Owens both further fail to teach a wall patch having an aperture adapted to surround a wall element (*see* claims 6 and 19), let alone the specific wall elements of dependent claims 7 and 20. The art of record also lacks a reinforcement member surrounding the claimed aperture (*see* claims 9 and 21).

CONCLUSION

For at least the foregoing reasons, Applicant requests reconsideration and allowance of claims 1-11 and 18-26 of the application as amended. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Craig R. Rogers
Reg. No. 43,888

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613
Customer No. 20575

I hereby certify that this correspondence
is being transmitted to the U.S. Patent and
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Signature



Deanna Brusco

Docket No. 2295-3

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Application No. 10/728,647

U.S. Patent Application Serial No. 10/728,647
MJM Docket No. 2295-3

INVENTORSHIP DECLARATION OF JERRY E. BROWER

1. I, Jerry E. Brower declare that I am the President of Wall Repair Systems Inc. ("WRS") and that I am the assignee/owner of U.S. Patent No. 6,607,621 and its continuations and divisionals, including the present U.S. Patent Application Serial No. 10/728,647. I am personally familiar with the invention shown, described, and claimed in this application including the inventive contributions of each of the named inventors.
2. Randall Eric Swanson ("Swanson") is the sole inventor of the subject matter disclosed and claimed in the parent application, U.S. Patent Application Serial No. 09/595,635, now U.S. Patent No. 6,607,621.
3. Swanson, for instance, contributed the concept of a ready-to-paint wall repair patch. Swanson also contributed the ideas of a pre-textured surface and feathered patch edges.
4. I am a co-inventor of certain claims of the present application, including the new matter added to the present application.
5. Among other things, I contributed the concept of providing a wall patch, such as the wall patch disclosed and claimed in U.S. Patent No. 6,607,621, with an aperture or cutout area to allow it to mate with a wall element, such as a light switch, power outlet, cable jack, phone jack, or other wall element, for example.

Under penalty of perjury, I declare the foregoing to be true and correct to the best of my knowledge and understanding.

Jerry E. Brower

Jerry E. Brower
President
Wall Repair Systems Inc.

11/27/2006

Dated